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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/076,660	02/15/2002	Robert Lance Cook	25791.76	9727

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HAYNES AND BOONE, LLP
901 MAIN STREET
SUITE 3100
DALLAS, TX 75202-3789

EXAMINER

CHAMBERS, A MICHAEL

ART UNIT	PAPER NUMBER
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3753

DATE MAILED: 09/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/076,660

Applicant(s)

COOK ET AL.

Examiner

A. Michael Chambers

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7, 17 and 19-30 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 7, 17 and 19-30 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. This action is in response to an amendment filed June 14, 2006. An amendment to the specification (15 pages) stating numerous documents and applications has been entered. Applicants are asked to discuss those applications which are continuations/continuations-in-part and/or divisionals. **A discussion of those applications which are deemed by applicants to be “related” are of no relevance.** Previously, a compliant amendment has been filed in response to the Notice of Non-Compliant Amendment filed September 2, 2005. Claim 19 has been amended to correct a punctuation error. This action is further in response to a preliminary amendment filed February 15, 2002. Claims 1-6 and 8-16 have been previously been canceled. **In the preliminary amendment filed February 15, 2002, applicants discuss a restriction requirement which includes inventions I-XI and state that the present invention claims are “...generally directed to the invention of group X...”. To expedite prosecution of the instant application, applicants are again asked to provide a copy of that restriction requirement in response to this Office action.** Applicants now state that informational disclosure Statements (9) have been filed February 15, 2002, May 31, 2002, April 4, 2003, April 7, 2003, October 31, 2003, August 2, 2004, January 25, 2005, August 30, 2005, and January 31, 2006. Applicants are asked to state the relevance/status of the May 31, 2003 statement (2 IDS) which was earlier stated to have to filed in the instant application. These missing IDS provide further evidence to support the examiner’s request as discussed below for applicants to provide a discussion of the relevant prior art in their IDS filed as “suggested in the MPEP.”. The Office has received at least 14 IDS which have been filed in the instant application. **In view of the extensive number of citations and the number of**

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copending and/or related applications cited in the specification, applicants are again asked to provide a discussion of the prior art deemed most relevant to the elected invention of Group X. The May 31, 2003, has NOT been received. Further a number of IDS have been filed on the dates listed above and not just a single filing. For example, January 25, 2005 (2 IDS; a number of 1449's). Applicants' statement that they decline to discuss relevant prior art of the invention X in view of their statement that it is "...generally directed to the invention of group X..." and even their not knowing what prior art statements have been filed in the instant application is not understood. Applicants' are asked to reconsider their statement on page 19 with regard to duty of disclosure under 37 C.F.R. 1.56. **Consideration of the IDS which comply with 37 CFR 1.97 and 1.98 will be made when the above issues are reconsidered by applicants.** Applicants discussion of the relevant sections of the MPEP has been considered, however common sense and courtesy should prevail and the most relevant prior art from an extremely long list of documents should be discussed by the applicants. **The applicants compiled the documents and are in a much better position to easily determine those documents from their numerous IDS filed those which are relevant to the prosecution of the instant application. Until such reconsideration by applicants of the what IDS have been filed and the relevant documents in those numerous IDS, consideration of all IDS by the examiner has been held in abeyance.** Applicants updating of the status of pending applications (Patent numbers 6,568,471; 6,328,113; 6,497,289; 6,823,937, 6,575,240 and serial number 09/510,913) cited in the instant application specification is noted. Applicants are continue to maintain a clear line of demarcation between the subject matter of applicants' prior patents/application and the instant application. Claim 18 has been cancelled in this amendment.

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Claims 7, 19, 21, 24, 25 and 27-29 have been amended. Claims 7 and 17, and 19-30 are pending.

In view of the cancellation of claims drawn to the remaining inventions ten inventions, the restriction has previously been made FINAL. An action on the merits of method claims 7 and 17, and 19-30 (dependent thereon and independent claim 30) is again included in this Office action.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or unobviousness.

5. Claims 7 and 17, and 19-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stout et al (Figure 4A). Note the disclosure of a "ball plug" 38 which when disposed on seat 40 in the inlet of the "apparatus for controlling the flow of fluidic materials" blocks the inlet of the throat passage to allow injected fluid pressure in tubing chamber to increase (column 5, lines 1+) and control piston. A screen 44 to control debris is disclosed. Predetermined hydraulic actuation pressures (which would be within the ranges recited) are disclosed in column 8, lines 21+. The passage in the apparatus is blocked and unblocked in response to shearing of the "piston" 90 "shear pin" 136. The rate would be controlled by the characteristics of the shear pin selected. Contrary to applicants' remarks the "...opening of the outlet passage..." occurs when the "shear pin" 136 breaks and the passage 134 allows fluid communication from the inlet to the outlet (i.e., opening an outlet passage). With regard to remarks drawn to claim 30, as above, the pressure required for actuation is a function of the shear pin selected which is deemed design choice. Stout et al discuss such design choice in column 8, lines 35+. **Motivation remarks are not deemed relevant in that a single patent has been applied as a teaching of the claimed subject matter. It would have been obvious to one of ordinary skill in the art to operate the apparatus of Stout et al by the recited method steps.** Stout teaches an apparatus which the elements and their interrelationships which would allow one of ordinary skill in the art to operate it by the recited steps and within the operational parameters recited. Motivation to operate the apparatus by the recited method steps is not required-only an apparatus which has those elements and their interrelationships to perform the method steps recited in the claims. Subsequent remarks, drawn to the remaining claims, include "similar lack of motivation statements" and as above are stated above "motivation" is not required to meet the recitation of the method steps of the instant application.

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Conclusion

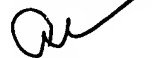
6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. Michael Chambers whose telephone number is 571-272-4908.

The examiner can normally be reached on Mon-Thur. 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Keasel can be reached on 571-272-4929. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



A. Michael Chambers
Primary Examiner
Art Unit 3753

amc
08/16/06